

**REMARKS**

Claims 1-5, 8, 10, 11, 13, 15-23, 25-37, 59-77, and 102-104 are presently pending. By the present amendment, claims 1, 3-5, 17, 18, 20-23, 27-29, 31, 33, 34, 59, 60, 62, 64, 67, and 73 have been amended, claims 38-58 and 78-101 have been canceled, and claims 102-104 have been added. It is respectfully submitted that the claims pending in the application do not introduce new subject matter, are fully supported by the specification, and are patentable over the cited prior art. Prompt and favorable consideration of these claims is earnestly sought.

Claims 1, 8, 10, 11, 13, 15-19, 27-30, 38-42, 47-51, 53-55, 59-62, 64-70, 72, and 73 stand rejected under 35 U.S.C. § 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 (a) as unpatentable over U.S. Patent No. 3,417,745 to Sheldon (the '745 patent).

As presently amended, claim 1 recites a method for working on a spine including, *inter alia*, the steps of "positioning a cannula to access the spine" and "introducing the apparatus through the cannula such that at least a portion of the expandable bladder is positioned between the adjacent vertebrae." Amended claim 27 recites a method for working on a spine including, *inter alia*, the steps of "positioning a cannula to access a spine" and "introducing at least a portion of the apparatus that includes the expandable bladder through the cannula to access the adjacent vertebrae." Amended claim 59 recites a method for working on a joint including, *inter alia*, the steps of "positioning a cannula to access a joint" and "introducing an expandable bladder into the joint through the cannula."

The '745 patent discloses a device for viewing regions of a patient's spine. In particular, the '745 patent discloses that the device has a closed distal end with a lens disposed in the distal end, thereby allowing the practitioner to view the spinal region using an endoscope that is positioned in the disclosed device. In addition, the inflatable member of the '745 patent is fluidly

• Appl. No. 10/729,668  
Amdt. dated March 7, 2006  
Reply to Office Action mailed December 13, 2005

coupled through a lumen to an external surface of the disclosed device. The inflatable member is configured and adapted to displace soft tissue and/or turbid fluid in the vicinity of the lens to improve viewing the spinal region. When used as a probe for insertion into a solid object, "the tip should be preferably rigid and sharply pointed to be able to pierce the examined object" (column 2, lines 67-70).

The '745 patent fails to disclose or suggest "positioning a cannula to access the spine" and "introducing the apparatus through the cannula such that at least a portion of the expandable bladder is positioned between the adjacent vertebrae" as recited in claim 1, or "positioning a cannula to access a spine" and "introducing at least a portion of the apparatus that includes the expandable bladder through the cannula to access the adjacent vertebrae" as recited in claim 27, or "positioning a cannula to access a joint" and "introducing an expandable bladder into the joint through the cannula" as recited in claim 59. In fact, not only is the '745 patent entirely silent on these recitations, the '745 patent teaches away from use with a cannula, which would not be used with the '745 device having a piercing, sharply pointed tip. Therefore, it is respectfully submitted that claims 1, 27, and 59 are not anticipated or suggested by the '745 patent and that the rejection of these claims has been overcome.

Since claims 8, 10, 11, 13 and 15-19 depend directly or indirectly from amended claim 1, claims 28-30 depend directly or indirectly from amended claim 27, and claims 60-62, 64-70, 72 and 73 depend directly or indirectly from amended claim 59, it is respectfully submitted that these claims are also not anticipated or suggested by the '745 patent. Claims 38-42, 47-51, and 53-55 have been canceled and it is respectfully requested that the rejection of these claims be withdrawn.

In the Office Action, claims 2-5, 20-23, 25, 26, 31-37, 52, 63, 71, 74, 78, 79, 82-84, and 89-101 were rejected under 35 U.S.C. § 103 (a) as unpatentable over the '745 patent. The rejection is traversed for the reasons below.

As discussed hereinabove, the '745 patent fails to anticipate or suggest the recitations of claim 1. Since claims 2-5 depend from claim 1, it is respectfully submitted that claims 2-5 are allowable over the '745 patent for at least this reason. Moreover, the '745 patent teaches away from performing an operation in conjunction with the device of the '745 patent. In particular, the '745 patent states that its device is for preoperative diagnosis and is distinguished from a subsequent operation or surgery (see column 1, lines 52-60). Any interpretation of the '745 patent to the contrary is based on impermissible hindsight using the pending claims as a roadmap.

As discussed hereinabove, the '745 patent fails to suggest or disclose "positioning a cannula to access a spine" and "introducing the apparatus through the cannula to access a space between the adjacent vertebrae" as recited in amended claim 20. Therefore, it is respectfully submitted that the recitations of claim 20 are not suggested by the '745 patent. Claims 21-23, 25, and 26 depend from claim 20 and it is respectfully submitted that these claims are also allowable over the '745 patent for at least this reason and the reasons discussed above with respect to claim 1.

As discussed hereinabove, amended claims 27 and 59 are not anticipated or suggested by the '745 patent. Since, claims 31-37 depend from claim 27 and claims 63, 71, and 74 depend from claim 59, it is respectfully submitted that these claims are also allowable over the '745 patent for at least this reason and the reasons discussed above with respect to claim 1. Claims 52, 78, 79, and 82-84 have been canceled and it is respectfully requested that the rejection of

Appl. No. 10/729,668  
Amdt. dated March 7, 2006  
Reply to Office Action mailed December 13, 2005

these claims be withdrawn.

The Office Action rejected claims 56-58, 75-77, and 81 under 35 U.S.C. § 103 (a) as unpatentable over the '745 patent in view of U.S. Patent No. 4,501,266 to McDaniel (the '266 patent). According to the Office Action, the '745 patent does not disclose that the device may be used in a knee, but that the '266 patent discloses that the knee is an area of the body requiring surgical intervention and stated that it would have been obvious to use the device of the '745 patent in a knee. Claims 75-77 depend from amended claim 59. As discussed hereinabove, the '745 patent does not anticipate or suggest the method recited in amended claim 59.

Adding the disclosure of the '266 patent does not overcome the deficiencies of the '745 patent and does not suggest, *inter alia*, "positioning a cannula to access a joint" and "introducing an expandable bladder into the joint through the cannula" as recited in amended claim 59. Therefore, it is respectfully submitted that claims 75-77 are also allowable over the '745 patent in view of the '266 patent for at least the reason that they depend from an allowable independent claim.

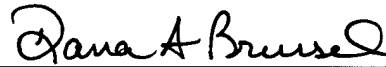
The Office Action rejected claims 1-5, 8, 10, 11, 13, 15-23, 25-42, 47-79, 81-84, and 89-101 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,017,305. By the present amendment, the Applicant has canceled claims 38-42, 47-58, 78, 79, 81-84, and 89-101. The Applicant will submit a suitable terminal disclaimer upon indication that claims 1-5, 8, 10, 11, 13, 15-23, 25-37, and 59-77 are otherwise allowable.

Appl. No. 10/729,668  
Amdt. dated March 7, 2006  
Reply to Office Action mailed December 13, 2005

The Applicant has added new claims 102-104 which depend directly from independent claims 1, 27, and 59 respectively. As discussed hereinabove, claims 1, 27, and 59 are not anticipated or suggested by the '745 patent. Therefore, it is respectfully submitted that new claims 102-104 are allowable over the '745 patent for at least the reason that they depend from allowable independent claims.

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims pending in the application, namely claims 1-5, 8, 10, 11, 13, 15-23, 25-37, 59-77, and 102-104, are in condition for allowance. Should the Examiner desire a telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5713.

Respectfully submitted,



Dana A. Brussel  
Reg. No. 45,717  
Attorney for Applicant

Carter, DeLuca, Farrell & Schmidt, LLP  
445 Broad Hollow Road - Suite 225  
Melville, New York 11747  
Tel.: (631) 501-5713  
Fax: (631) 501-3526

**Send correspondence to:**  
Chief Patent Counsel  
Tyco Healthcare Group  
195 McDermott Road  
North Haven, CT 06473